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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,998	03/30/2004	Ruey J. Yu	BMR-001/C2	2680
70813	7590	11/28/2007		
GOODWIN PROCTER LLP 901 NEW YORK AVENUE, N.W. WASHINGTON, DC 20001			EXAMINER SCHLIENTZ, NATHAN W	
			ART UNIT	PAPER NUMBER
			1616	
			NOTIFICATION DATE	DELIVERY MODE
			11/28/2007	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/811,998	<b>Applicant(s)</b> YU ET AL.	
	<b>Examiner</b> Nathan W. Schlientz	<b>Art Unit</b> 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 111-121, 149, 152 and 159-161 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 111-121, 149, 152 and 159-161 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Claims***

Claims 111-121, 149, 152 and 159-161 are pending. Claims 111-112 and 149 are amended, and claims 122-148, 150-151, 153-158 and 162 are cancelled in an Amendment filed 29 October 2007. Therefore, claims 111-121, 149, 152 and 159-161 are examined herein on the merits for patentability. No claim is allowed at this time.

### ***Terminal Disclaimer***

The terminal disclaimer filed on 29 October 2007 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent Nos. 6,335,023 and 6,740,327 has been received. The rejection of claims 111-121, 149-151 and 159-161 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 8 and 14 of U.S. 5,942,250 and claims 1-7, 20-26, 29-30, 43-49 and 52-56 of U.S. 6,335,023 is maintained pending the approval of the aforementioned Terminal Disclaimer. Upon approval of the TD, the rejection will be withdrawn by the examiner.

### ***Withdrawn Rejections***

1. The rejection of claims 149-150, 153 and 159 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 and 3 of U.S. Patent No. 5,561,157 is hereby **withdrawn** by the examiner in light of the

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aforementioned claim amendments deleting lactobionic acid and maltobionic acid from the list of aldobionic acids.

2. The rejection of claims 149-150 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 15, 23, 27-29 and 32-35 of U.S. Patent No. 5,877,212 is hereby **withdrawn** by the examiner in light of the aforementioned claim amendments deleting lactobionic acid and maltobionic acid from the list of aldobionic acids.

3. The rejection of claims 149-150 and 152-153 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 8 and 14 of U.S. Patent No. 5,942,250 is hereby **withdrawn** by the examiner in light of the aforementioned claim amendments deleting lactobionic acid and maltobionic acid from the list of aldobionic acids.

4. The rejection of claims 111-121, 149-151 and 159-161 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7, 20-26, 29-30, 43-49 and 52-56 of U.S. Patent No. 6,335,023 is hereby **withdrawn** by the examiner in light of the aforementioned Terminal Disclaimer filed 29 October 2007.

5. The rejection of claims 111-121, 149-151 and 159-161 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-

10, 32-34, 36-41 and 46-48 of U.S. Patent No. 6,740,327 is hereby **withdrawn** by the examiner in light of the aforementioned Terminal Disclaimer filed 29 October 2007.

6. The provisional rejection of claims 111-115 and 149-154 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 21-22, 29 and 35-36 of U.S. Patent Application No. 10/792,273 is hereby **withdrawn** by the examiner in light of the aforementioned claim amendments deleting maltobionic acid from the list of aldobionic acids.

7. The provisional rejection of claims 111-115 and 149-154 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 21-22 and 29 of U.S. Patent Application No. 10/792,273 is hereby **withdrawn** by the examiner in light of the aforementioned claim amendments deleting maltobionic acid from the list of aldobionic acids.

### ***Claim Rejections - 35 USC § 112***

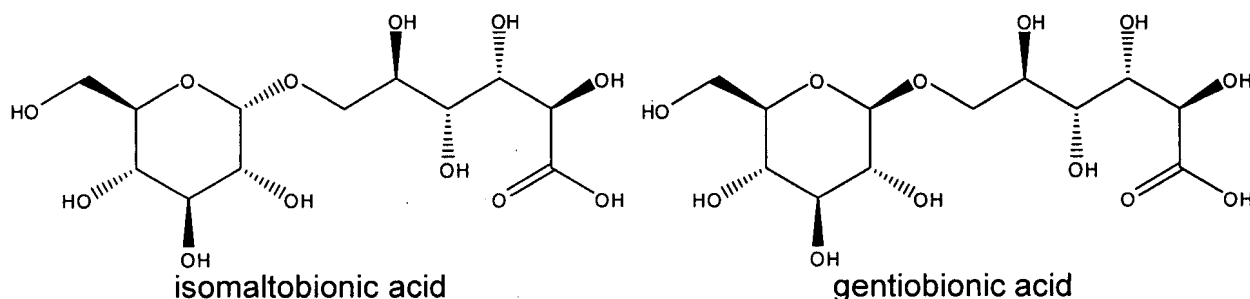
The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 111-121, 149, 152 and 159-161 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claims 111, 149 and 159-161 are drawn to compositions comprising at least one aldobionic

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acid selected from the group listed in the instant claims as free acid, ester, salt, lactone, **stereoisomeric**, **non-stereoisomeric**, **saturated** or **unsaturated**, **straight** or **branched chain**, or cyclic forms thereof. However, it is not clear how the specific compounds listed in the instant claims can exist as **stereoisomeric**, **non-stereoisomeric**, **saturated** or **unsaturated**, or **straight** or **branched chain** forms. The compounds listed in the instant claims have specific structures with specific R and S conformations at the chiral centers. For example isomaltobionic acid and gentiobionic acid depicted below.



Therefore, it is confusing as to how the compounds of the instantly claimed compounds can exist as **stereoisomeric**, **non-stereoisomeric**, **saturated** or **unsaturated**, or **straight** or **branched chain** forms. Thus, the metes and bounds of the instant claims are not clearly defined and cannot be ascertained.

2. Claim 152 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claim 152 is drawn to the "antioxidant composition of claim 149, wherein the antioxidant composition is used for the prevention and/or treatment against damage from... **other oxidative damages to the skin, hair,**

**and nails.**" However, it is not clear what is encompassed by the teaching of "**other oxidative damages to the skin, hair, and nails.**" The instant specification does not describe **other oxidative damages to the skin, hair, and nails**, and thus the metes and bounds of the instant claim are not clearly defined and cannot be ascertained.

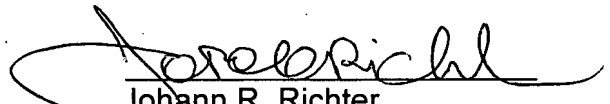
### **Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan W. Schlientz whose telephone number is 571-272-9924. The examiner can normally be reached on 8:30 AM to 5:00 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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